

Appl. No. 10/696,813
Examiner: Hewitt, James M, Art Unit 3679
In response to the Office Action dated April 22, 2005

Date: July 22, 2005
Attorney Docket No. 10111394

REMARKS

Responsive to the Office Action mailed on April 22, 2005 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

Present Status of Application

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Higgs (U.S. Patent No. 5,249,319). Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Chaffee (U.S. Pub. No. 2001/0044969). Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hargin (U.S. Patent No. 388,037).

In this paper, claims 1-4 are amended. Namely, claim 1 is amended to recite that the inflatable product comprises a first valve for opening and closing a first air outlet, wherein the first valve is received in a pack. Support for the amendment to claim 1 can be found in original claim 3. Claims 3 is amended to correspond to the amendment of claim 1. Claims 2 and 4 are amended to correct informalities. New claims 5-15 are added. Support for the new claims can be found on page 8, line 25 to page 9, line 28 and on page 11, line 27 to page 12, line 9 of the specification.

Reconsideration of this application is respectfully requested in light of the amendments and the remarks contained below.

Rejections Under 35 U.S.C. 102

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Higgs. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Chaffee. To the extent that the grounds of the rejections may be applied to the claims now pending in this application, they are respectfully traversed.

Chaffee teaches an inflatable device with a recessed fluid controller. Higgs teaches a mattress system having a blower disposed in the hollow interior of a foam strip.

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To anticipate a claim, a reference must teach every element of the claim. In this regard, the Federal Circuit has held:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As amended, claim 1 recites the limitation of a first valve for opening and closing the first air outlet, wherein the first valve is received in the pack. This feature, originally recited in claim 3, is not found in either Higgs or Chaffee.

For at least the reasons described above, it is Applicant's belief that neither Higgs nor Chaffee teach or suggest all the limitations of claim 1 as amended. Applicant therefore respectfully requests that the rejections of claim 1 under 35 U.S.C. 102 be withdrawn and the claim passed to issue. Insofar as claims 2-7 depend from claim 1 either directly or indirectly, and therefore incorporate all of the limitations of claim 1, it is Applicant's belief that these claims are also in condition for allowance.

Rejections Under 35 U.S.C. 103

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hargin. To the extent that the grounds of the rejections may be applied to the claims now pending in this application, they are respectfully traversed.

Hargin teaches a flotation device provided with a spring-actuated pump.

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As amended, claim 1 recites an inflatable product including a first chamber, a pack, and a fan and motor received in the pack. The pack has an air intake connected to the outside of the first chamber and a first air outlet connected to the inside of the first chamber. A first valve for opening and closing the first air outlet is received in the pack. Air is pumped by the fan and motor from the outside of the first chamber through the air intake and the first valve and then into the first chamber from the first air outlet.

MPEP 2142 reads in part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Hargin fails to teach the combination of the pack, the fan and motor received in the pack, and the first valve also received in the pack for opening and closing the first air outlet, as recited in claim 1. Furthermore, Applicant disagrees that it is obvious to replace the spring-actuated pump of Hargin with a fan and motor. In this regard, Applicant notes that Hargin describes a flotation device for use as a life raft. The addition of a fan and motor would entirely change the principal of operation of the flotation device, and require a complete redesign of the product.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In the case, the court held the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate."

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As it is Applicant's belief that a *prima facie* case of obviousness is not established in connection with claim 1, the Examiner's arguments in connection with the dependent claims 2-3 are considered moot and are be addressed here. Withdrawal of the rejections of claims 1-3 under 35 U.S.C. 103 is respectfully requested.

New Claims 5-15

As noted previously, new claims 5-7 are believed to be allowable by virtue of their dependency from claim 1.

Furthermore, new claim 5 recites a valve switch to selectively open the first valve or the second valve of claims 1 and 3. Applicant notes that the Examiner took official notice of the use of a switch to open a valve in the office action dated April 22, 2005. However, valve (g') of Hargin is fully enclosed with the air tight covering of the flotation device, and is therefore inaccessible to a user. See column 4, lines 123-131 and Figs. 1 and 4 of Hargin. There would be no motivation to modify the valve (g') to include a switch that cannot be accessed by a user.

New claim 6 recites that the valve switch includes a cam element, a bar and a spring, the cam element is rotated between a first orientation and a second orientation, and when the cam element is in the first orientation, the bar is depressed by the cam element, and the spring is compressed by the bar to open the first valve or the second valve. New claim 7 recites that the cam element has a recess, and when the cam element is in the second orientation, the bar is pushed by the spring and received in the recess to close the first valve or the second valve. Applicant submits that none of these features are found in the prior art cited by the Examiner.

New claim 8 recites an inflatable product including a first chamber; a pack having an air intake connected to the outside of the first chamber and a first air outlet connected to the inside of the first chamber; a first valve for manually opening and closing the first air outlet, wherein the first valve is connected to the pack; a motor connected to a fan for rotating the fan to pump air from the outside of the first chamber through the air intake and the first valve and then into the first chamber from the first air outlet. Applicant submits that the prior art cited by the Examiner does not teach or suggest an inflatable product having these features. For at least this reason, it is Applicant's belief that claim 8 is allowable over the cited references. Insofar as claims 9-15

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depend from claim 8 either directly or indirectly, and therefore incorporate all of the limitations of claim 8, it is Applicant's belief that these claims are also in condition for allowance.

Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so.

Respectfully submitted,



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